

SEP 21 2006

Application No. 10/687,387
Amendment dated September 21, 2006
Reply to Office Action of June 21, 2006

Docket No.: 66209-0001

REMARKS

Applicant has carefully reviewed the Office Action mailed June 21, 2006. In response to the Office Action, Applicant has amended claims 1 and 6, and canceled claim 8. By way of this amendment, no new matter has been added. Claims 3 and 10-14 were previously cancelled. Accordingly, claims 1, 2, 4-7, 9 and 15-22 remain pending in this application. At least for the reasons set forth below, Applicant respectfully traverses the foregoing rejections. Further, Applicant believes that there are also reasons other than those set forth below why the pending claims are patentable, and reserves the right to set forth those reasons, and to argue for the patentability of claims not explicitly addressed herein, in future papers. Applicant respectfully requests reconsideration of the present application in view of the above amendment, the new claims, and the following remarks.

Claim Rejections – 35 USC § 103

Claims 1, 2, 4-9, and 15-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bergagnini in view of O'Callaghan and BCBS. Applicant respectfully traverses the rejection.

Proposed Combination does not Teach All Elements

MPEP Section 2143 sets forth the basic requirements for the Patent and Trademark Office to establish prima facie obviousness as follows: "To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j).

Independent claims 1 and 6, as amended, positively recite a pendant having an opening and a piece of wool that "extends into said opening." In contrast, none of the references of record disclose wool that extends into an opening. Furthermore, the Examiner's combination,

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assuming *arguendo* that a combination can be properly made, does not disclose any item within a pendant that extends into an opening within a face of the pendant. Importantly, applicant notes that O'Callaghan discloses "a piece of brown cloth 19 is secured adhesively" to a frame piece 11, and the brown cloth 19 is clearly illustrated in FIGS. 4 and 6 of O'Callaghan to not extend away from the frame 11 and toward the casings 10. (O'Callaghan, column 2, line 2) Therefore, O'Callaghan cannot teach a cloth 19 that extends through an opening, even if the Examiner were to form an opening in one of the casings 10. Accordingly, the Examiner has failed to identify all elements of the recited independent claims, as required in *In re Royka*.

No Motivation for the Proposed Combination

In re Fritch provides that "the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art," and that "the Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." 23 USPQ2d 1780, at 1783. In focusing efforts to meet this burden, the Federal Circuit has concluded that "under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (Emphasis in original)

"If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453 at 1457 (Fed Cir. 1998). "Rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability'." *Id.* quoting *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

"The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure." *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out by the reference." *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994).

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The Examiner has combined the non-religious assembly 11 of Bergagnini with the cloth 19 of O'Callaghan and the wool of BCBS without identifying any motivation within the references for the proposed combination. However, the Examiner has provided a motivation as "to have a more meaningful religious effect on the wearer." In contrast, and in disagreement with the Examiner's assertions, BCBS discusses a scapular made of cloth and a scapular medal, then concludes that "the scapular medal enjoys all the privileges granted to the wearing of the scapular" made with cloth. (BCBS, page 3 of 3) Therefore, BCBS affirmatively teaches that the religious effect on the wearer is identical whether the scapular is made of cloth or a medal, and teaches away from the proposed combination.

Importantly, the Examiner's motivation for the proposed combination. "to have a more meaningful religious effect on the wearer," appears to come from the Applicant's specification, paragraph [0004], last sentence. Accordingly, the Examiner has failed to provide adequate motivation for the proposed combination, as required in *In re Vaeck*.

Additionally, the Examiner is respectfully requested, under the authority of *In re Fritch*, to provide the motivation for the proposed combination. Applicants cannot locate any motivation within the references to support this combination.

**Proposed Combination would change the Principle of Operation of the
Prior Art Invention being Modified**

If the proposed modification makes the prior art reference wholly unsuitable for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). If the proposed modification or combination of references would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The Examiner proposes to replace the shaped settings 35 of Bergagnini with the cloth 19 of O'Callaghan. However, the stated purpose of Bergagnini is to provide a window 22 for the shaped setting 35 to be visible from outside the assembly 11. (Bergagnini, column 1, lines 29-35) Further, Bergagnini proceeds to explain that the window 22 is formed in the assembly 11 since the window 22 is easier to form than a shaped setting array of a custom shape. (see Bergagnini, column 1, lines 44-53, and column 3, lines 16-23) If one of skill in the art were to

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be motivated by the Examiner to replace the shaped setting 35 of Bergagnini with the cloth 19 of O'Callaghan in the assembly 11 of Bergagnini, one would form a modified assembly 11 where the window 22 were more difficult to form than would be cutting the cloth 19. Therefore, the "proposed modification or combination of references would change the principle of operation of the prior art invention being modified," since one of skill in the art would recognize that the window 22 would no longer be desired as taught in Bergagnini. Accordingly, the proposed modification runs afoul of the prohibition of *In re Ratti*.

Dependent claims 2, 4-5, 7, 9, and 15-22 teach independently patentable subject matter, although they are also patentable merely by being dependent on an allowable base claim. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Conclusion

In view of the above amendment and remarks, the pending application is in condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative.

It is believed no fees are due with this response. However, if any additional fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge our Deposit Account No. 18-0013, under Order No. 66209-0001 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136 is hereby made, the fee for which should also be charged to this Deposit Account.

Dated: September 21, 2006

Respectfully submitted,

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